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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,557	04/05/2001	Akira Oomori	CANO:023	5306

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ROSSI & ASSOCIATES
P.O. Box 826
Ashburn, VA 20146-0826

EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 05/18/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/826,557

Applicant(s)

OOMORI, AKIRA

Examiner

Khanh Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9 are directed to an apparatus. However, the essential structural cooperative relationships between all elements in the claims have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al.

At the outset, it is noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure/step that differs from Johnson et al. With regard to claims 1 and 19, Johnson et al. discloses a data communication apparatus comprising input means (keypad 14, for example) for inputting data; designating means (receiver destination including destination addresses/distribution list, for example, in Johnson et al.) for designating a plurality of destinations for same data input by the input means, the plurality of destinations (destination addresses) being destinations to which data are to be transmitted by respective different transmission methods; transmitting means for transmitting the same data to the plurality of destinations designated by the designating means by the respective different transmission methods (in Johnson, the same data can be transmitted to a plurality of transmission paths to a plurality of destinations; see also Figs. 2 and 3 and description thereof); and managing means (in Johnson et al., the transmission status, for example, can be managed/updated) for managing information related to transmission by the transmitting means by associating a predetermined identifier (ID in Johnson et al.) with each of the data input by the input means. With regard to claim 2, the device of Johnson et al. further comprises display means (58) for displaying a list based on the information managed by the managing means. With regard to claim 3, it is clear that in Johnson et al., data can be transmitted using at least one transmission method of E-mail and FTP (File Transfer Protocol). With regard to claim 4, it is clear that at least the scanner (10) of Johnson et al. is readable as a reader for reading images on originals and generating image data corresponding to the images. It is also clear from Johnson et al.; and that data from the reader can be

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provided to the input means. With regard to claim 5 (as best understood), see at least Figs. 2 and 3, and description thereof). With regard to claim 6, it is clear that a user is able to provide instructions to the system of Johnson et al. With regard to claim 7, it is clear from Johnson et al. that a user is able to stop/interrupt data transmission associated with a particular transmission method and identified by their IDs; or even change the destination of the transmission data. See at least col. 3, lines 63 to col. 5, line 28. With regard to claims 10-18, one using the apparatus of Johnson et al. would have performed the same method steps set forth in claims 10-18.

Response to Arguments

Applicants' arguments filed 3/29/2004 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

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With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The 112 Rejection:

Applicant's amendments to the claims still have not provided structural relationships between structural elements in the claims. MPEP 2172.01 clearly states that "a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). It is clear that various recited elements function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes.

The Johnson 102 Rejection:


Applicant argued that Johnson does not disclose "assigning the same predetermined identifier to each of the plurality of transmission of the same data." However, such an argument is contrary to Applicant's own concession that in Johnson, "[d]ifferent job numbers or IDs are assigned to different destination addresses" (see page 2 of Applicant's remarks). As conceded by Applicant, in Johnson, a plurality of transmissions of the same data are assigned different destination addresses (IDs). In

another word, the same destination address (ID) is assigned to each of a plurality of transmission of the same data.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.



Khanh Dang
Primary Examiner